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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,370	08/20/2003	Gustavo E. Tamayo	6517-002	6417

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NEW YORK, NY 100160601

EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

03

Office Action Summary	Application No. 10/644,370	Applicant(s) TAMAYO ET AL.	
	Examiner Ahmed M Farah	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep. 13, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17-22 are again rejected under 35 U.S.C. 102(b) as being anticipated by Swinger U.S. Pat. No. 5,647,865.

Swinger discloses a surgical laser and methods of use or correcting refractive disorders of the eye such as myopia and presbyopia by controlling the energy flux, beam diameter, and the exposure time of the treatment. He teaches that a multifocal lens is created in the cornea by appropriately distributing the laser energy over various optic zones such that the patient has a clear vision both for distant vision and for near vision. See the abstract; Col. 7, lines 10-20; and Col. 8, lines 30-34. The energy controller of Swinger is adapted to deliver ablating laser beams on selected corneal surfaces to treat vision a desired vision disorder.

In reference to claim 18, Swinger teaches that the diameter of the ablation varies depending on the procedure being performed, but it is usually greater in diameter than the critical central optically used zone of the cornea, which is typically in the range of 5-8 mm (see Col. 4, lines 52-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rehse et al. U.S. patent 5,754,270 in view of Swinger U.S. Patent no. 5,647,865.

Rehse et al. disclose multifocal lens designs that are configured as contact lenses or intraocular lenses for correcting presbyopia of patient's eye. In one embodiment of their invention, the lens is configured to form a peripheral optical zone in a cornea having a high refractive power to provide corrected near vision for the patient, the optical zone located peripheral concentric with a centrally located optical zone as presently claimed (Col. 6, lines 17-23).

In this Office action the term "peripheral zone in the cornea," unless otherwise defined, is treated as any zone in the corneal surface that is outside the center of the pupil.

As to claims 2 and 3, Rehse et al. teach that a peripheral optical zone (the third optic zone **75**), which has a diameter of 8 mm provides a range of power for correcting near vision deficiency (see the Table in col. 4; and col. 6, lines 26-27). The diameter of this optical zone exceeds 5.5mm and is less than 10mm.

As to claim 7, they teach that the refractive power of a central zone of the cornea (the first optic zone **71** and second optic zone **73**) disposed concentrically with the

peripheral zone (third optic zone **75**) is used for vision correction other than near vision as presently claimed (see col. 6, lines 23-25).

Although Rehse et al. disclose methods of correcting vision disorders of the eye with the aid of contact and/or intraocular lenses, they fail to teach a method for ablating the cornea to achieve the desired vision corrections. However, the use of surgical techniques of the cornea as an alternative method to contact and/or intraocular vision lenses for vision correction is well known in the medical art. Swinger, described above, teaches a corneal surgical apparatus and methods of use for correcting vision disorders of a patient's eye.

Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Rehse et al. in view of Swinger and use a surgical technique as an equivalent alternative method for correction vision disorders of the eye. The surgical method would further provide permanent correction to the vision disorder of the eye.

Response to Arguments

Applicant's arguments filed September 13, 2004, have been fully considered but they are not persuasive.

In the remarks, the applicant states that "claim 17 discloses an apparatus in which the controller ablates a peripheral portion of the cornea to increase its optical power to provide near vision." He further argues that neither the prior art nor Swinger teaches this feature.

In response to this argument, the controller device of Swinger is adapted to provide laser energy to different zones of the corneal surface to treat vision disorders of the eye. The controller of Swinger scans laser light on the corneal surface and is capable to provide laser energy onto any optical zone of the eye. The recitation "to provide near vision" in the claim is an intended use and it is not given a patentable weight. Hence, the Examiner maintains his prior rejection of claims 17-22.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M Farah whose telephone number is (703) 305-

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5787. The examiner can normally be reached on Mon-Thur. 9:30 AM-7:30 PM, and 9:30 AM - 6:30 PM on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M DVorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Farah
Primary Patent Examiner, AU 3739



November 28, 2004.